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REMARKS

By the Office Action of mailed June 22, 2006, Paper No. 06162006, Claims 48-54 are pending. Applicants thank Examiner Tawfik for the allowance of claims 45-47 and 52-54.

**1. The Rejection of Claims 48-51 Under 35 U.S.C. §103(a)**

Claims 48-51 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Mattei et al. (U.S. 4,887,408) in view of WO 9856662A.

Applicants respectfully request reconsideration and withdrawal of the remaining rejections. As set forth below, the rejections are respectfully traversed.

**A. The Subject Matter of the Rejected Claims**

There is only one independent claim among the rejected claims presently pending, namely claim 48.

Claims 48 recites a process in which the order of the process steps is such that the side tabs of the wrapper are overlapped and thermally pre-sealed and the bottom and top tabs are overlapped and thermally pre-sealed, and subsequently, the side tabs are permanently sealed and the bottom and top tabs are permanently sealed.

**B. The Cited References Fail to Teach or Support All of the Elements of the Claims**

Applicant respectfully submits the cited references fail to teach or suggest the order of the steps of claim 48, namely that the side tabs are overlapped and pre-sealed and the top and bottom transverse and longitudinal tabs are overlapped and pre-sealed before either the side tabs or the end top and bottom transverse and longitudinal tabs are permanently sealed.

Mattei et al. (U.S. 4,887,408) fails to teach, disclose or suggest the order of the steps of claim 48. The Office Action refers to Figs. 1, 2 and 3 for the basis of the rejection of claim 48. More particularly, the Office Action comments that: "Mattei discloses a process for folding and sealing a wrapper on a dimensionally stable pack comprising the following steps providing a wrapping film (Fig. 2; via 4) for forming the wrapper; wrapping the wrapping film around the pack to form side tabs (Figs. 1 and 3; via 61 and 63), bottom tabs, and top tabs (Figs. 1 and 3; via 9 and 10); causing the side tabs to overlap one another (Figs. 1 and 3); thermally pre-sealing the side tabs (Fig. 2; via 1<sup>st</sup>. sealing station 41); causing the bottom tabs to overlap one another and the top tabs to overlap one another (Figs. 2); thermally pre-sealing the overlapping bottom and

side top tabs (Fig. 2; via 2<sup>nd</sup> sealing station 53); permanently sealing the side tabs (via 1<sup>st</sup> sealing stations 42 and 43); and subsequently permanently sealing the bottom and top tabs (Fig. 1; via 2<sup>nd</sup> sealing stations 54 and 55 located after the 1<sup>st</sup> sealing stations)."

Applicant respectfully submits that this description of the disclosure in Mattei in the Office Action is not correct. Mattei teaches that a wrapper is first folded around a cigarette pack such that flaps 61 and 63 are folded one over the other (See, e.g., Col. 4, lines 33-42). Thereafter, flaps 61 and 63 are fused together at 1<sup>st</sup> heat-seal stations 41, 42 and 43 in succession resulting in the permanent sealing of side tabs 61 and 63. (See, e.g., Col. 4, lines 43-48). At this point top and bottom tabs 9 and 10 have yet to be folded. Thereafter, the pack is advanced to fold station 47 where top and bottom ends 9 and 10 of each wrapper are folded one over the other (See, e.g., Col. 3, lines 38-50; Col. 4, lines 59-65). Thereafter, the pack is advanced to the second heat-seal stations 53, 54, and 55 where the flaps of the top 9 and bottom 10 are the wrapper are fused (See, e.g., Col. 4, lines 65-Col. 5, line 2). See generally, Col. 1, lines 39-55.

Thus, the description at Mattei at page 2 of the Office Action is incorrect in that the order of the steps disclosed by Mattei is not correctly stated in the Office Action. For example, the Office Action states that "Mattei discloses thermally pre-sealing the side tabs causing the bottom tabs to overlap one another and the top tabs to overlap one another (Fig. 2); thermally pre-sealing the overlapping top and bottom side tabs (Fig. 2, via 2<sup>nd</sup> sealing station 53; permanently sealing the side tabs (via 1<sup>st</sup> sealing stations 42 and 43)". Applicant respectfully submits that, for example, Mattei does not teach that the top and bottom tabs 9 and 10 are folded before permanent sealing of the side tabs 61 and 63. Fig. 2 clearly illustrates that the top tabs are not sealed until fold station 47, after sealing stations 41, 42 and 43 for the side tabs (note the exposed tops of the cigarettes in Fig. 2). Additionally, Mattei fails to disclose thermally pre-sealing overlapping bottom and top side tabs 9 and 10 before permanently sealing side tabs 61 and 63.

Applicant notes that the Office Action acknowledges that Mattei does not disclose that the permanently sealing of the side tabs are done subsequently after the steps of pre-sealing of the top and bottom tabs. The Office Action attempts to remedy this failure of disclosure in Mattei, commenting "It would have been obvious to one having ordinary skill in the art at the time the invention was made to have rearranged Mattei's sealing stations to have one of the first sealing stations to be located downward of the second sealing stations, in order to affirm the sealing of

the side tabs after finishing the step of the sealing of the top and bottom tabs, since it has been held that rearranging parts of an invention involves only routine skill in the art."

Applicant respectfully disputes this statement in the Office Action. First, the proposed modification to Mattei still would not meet the steps of claim 48 in that it would fail to provide folding of the top and bottom tabs 9 and 10 prior to permanently sealing side tabs 61 and 63 at sealing stations 41, 42, and 43 for the side tabs 61 and 63. Thus, more modification of Mattei is required to meet the recitations in claim 48 than proposed in the Office Action. Fold station 47 must also be modified. Applicant further respectfully submits that requiring modification of Mattei to both its folding stations and its heat sealing stations is contrary to the teachings of Mattei that the side tabs 61 and 63 be fused (permanently sealed) prior to the sealing of the top and bottom tabs 9 and 10.

Furthermore, the order of the steps recited in claim 48, namely that the side tabs are folded and pre-sealed and the top and bottom transverse and longitudinal tabs are folded and pre-sealed before either the side tabs or the bottom transverse and longitudinal tabs are permanently sealed is neither taught nor suggested by either of the cited references. To suggest the modification that would be required of Mattei would be obvious as involving "only routine skill in the art" is nothing more than a bare assertion that something is a "design choice", which is insufficient to establish a "suggestion" in the art for the claimed invention. See, e.g., *Northern Telecom, Inc. v. Datapoint Corp.*, 15 U.S.P.Q.2d 1331, 1323 (Fed. Cir. 1990). As set forth by the Board of Patent Appeals and Interferences, the statement that something is a design choice is a conclusion and is not a reason. *Ex parte Garrett*, 1986 Pat. App. Lexus 8 (Bd. Pat. App. Interferences, 1986).

No citation is presented in the Office Action to any place in either of the cited references where a motivation or suggestion is found to modify Mattei would be required. This suggests that the motivation for the required modifications comes only through hindsight from Applicants' own disclosure. Since the Office Action has not provided sufficient motivation for the claimed invention, or the required modification of Mattei, nor provided a reference showing desirability of the order of the steps of claim 48 to overcome the problems addressed by Applicants' method, the Office Action has not established a *prima facia* case of obviousness and this rejection should be withdrawn.

With respect to claim 49, Applicant respectfully notes an inherent inconsistency in the positions in the Office Action. In particular, the Office Action acknowledges at page 3 that Mattei does not disclose that the wrapping film is shrinkable. The Office Action goes on, however, to comment with respect to claim 49 that "Mattei discloses the pre-sealing steps and the permanent sealing steps do not initiate shrink wrapping of the film." This statement with respect to claim 49 makes no sense in view of the acknowledgement that Mattei does not disclose its wrapping film is shrinkable. Regarding claim 50, Applicant respectfully submits that no motivation or suggestion is shown to substitute the film used in Mattei with a shrink wrap film of the '662 reference. Regarding any remaining rejected claims, Applicant respectfully submits that these claims are considered allowable for the same reason as their base claim.

## 2. Fees

No fees are believed due as a result of this Response. The Office is authorized, however, to charge any fee deficiency in connection with this amendment to Deposit Account no. 20-0778.

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CONCLUSION

In view of the comments and remarks herein, Applicants respectfully submit that all of the pending claims are in condition for allowance. Accordingly, Applicants respectfully request early and favorable action. Should the Examiner have any further questions or reservations, the Examiner is invited to telephone the undersigned Attorney at 770.933.9500 (ext. 213).

Respectfully submitted,



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